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7590 Christopher John Rudy 209 Huron Ave., Ste. 8 Port Huron, MI 48060			EXAMINER PELLEGRINO, BRIAN E	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES O. TOWNLEY

Appeal 2010-000094
Application 10/758,455
Technology Center 3700

Before TONI R. SCHEINER, DONALD E. ADAMS, and
LORA M. GREEN, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 21-26, 28, 29, 31, 32, 34-37, and 40-42 (App. Br. 2). We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to a basal thumb joint implant. Claims 21 and 40 are representative and are reproduced in the "Claims Appendix" of Appellant's Brief (App. Br. CA-1 - CA-3).

The rejections presented by the Examiner follow:

1. Claims 21, 22, 25, 26, 28, 29, 40, and 41 stand rejected under 35 U.S.C. § 103(a) as unpatentable over McLaughlin.¹
2. Claim 23 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of McLaughlin and Townley.²
3. Claim 24 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of McLaughlin and Lane.³
4. Claims 31, 32, and 34-36 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of McLaughlin and Abouaf.⁴
5. Claim 37 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of McLaughlin and Wright.⁵
6. Claim 42 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of McLaughlin and ASTM.⁶

We reverse.

ISSUE

Does the preponderance of evidence on this record support a conclusion of obviousness?

¹ McLaughlin, US 5,507,818, issued Apr. 16, 1996.

² Townley, US 2,934,065, issued Nov. 1, 1954.

³ Lane et al., US 5,674,297, issued Oct. 7, 1997.

⁴ Abouaf et al., US 5,871,547, issued Feb. 16, 1999.

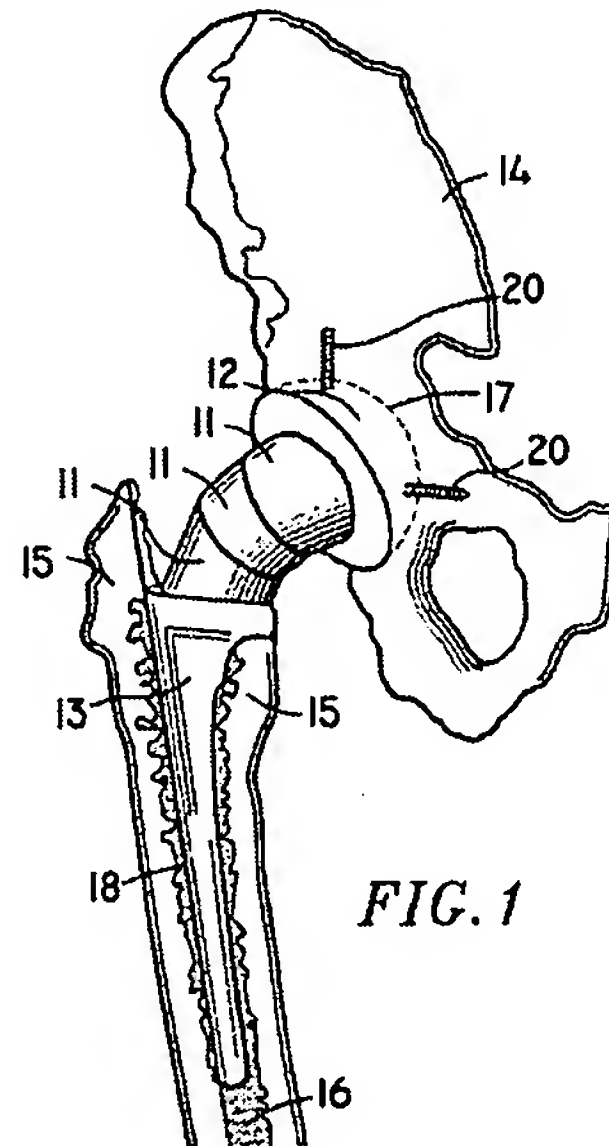
⁵ Wright Medical Technology – Swanson Titanium Basal Thumb Implant.

⁶ ASTM F 1377-98 *Standard Specification for Cobalt-28 Chromium-6 Molybdenum Powder for Coating of Orthopedic Implants (UNS-R30075)* 699-700 (1998).

FACTUAL FINDINGS

FF 1. The Examiner finds that McLaughlin teaches a modular joint prosthesis that has, *inter alia* a head **12** (Ans. 3).

FF 2. McLaughlin teaches a multipolar joint endoprosthesis as illustrated in McLaughlin's FIG. 1, reproduced below:



“FIG. 1 is a frontal view of a joint endoprosthesis embodying . . . [McLaughlin's] invention functioning as a hip endoprosthesis. The figure illustrates the orientation of the various components with the lower extremity in the anatomic position (i.e. standing)” (McLaughlin, col. 2, ll. 9-13).

FF 3. McLaughlin teaches that “proximal component **12** is firmly affixed to the proximal bony landmark (e[.]g. pelvis) **14** by means of methylmethacrylate bone cement, screws **20**, bony ingrowth, etc. in such a way that no motion occurs at the proximal component-bone interface **17**” (McLaughlin, col. 2, ll. 33-37).

ANALYSIS

Appellant's claim 21 requires, *inter alia*, a head that includes "a single, smooth, generally hemispherical medio-proximally directed, articulating surface" (Claim 21). Claim 21 further requires, *inter alia*, that the "articulating surface being continuous as to its sphericity and uninterrupted up to the end of said articulating surface so that said articulating surface defines a truncated ball of a shape that is from substantially hemispherical to greater than substantially hemispherical" (*id.*). Thus, Appellant's claim 21 requires the head to have an articulating surface that is, at least, substantially hemispherical. Claim 40, Appellant's only other independent claim, also requires, *inter alia*, the head to articulate about an articular surface for mounting (Claim 40).

Notwithstanding the Examiner's assertions to the contrary (FF 1), Appellant contends that McLaughlin's "proximal component 12 . . . is not a head of a joint or joint prosthesis" (App. Br. 6). In this regard, Appellant contends that McLaughlin teaches that "proximal component 12 is fixed with bone screws 20, glue, or bony ingrowth . . . so that its hemispherical surface does not articulate, in a socket or elsewhere" (*id.*). We agree (FF 2-3).

Based on the foregoing, Appellant contends that McLaughlin fails to suggest a head that includes an articulating surface as required by Appellant's claimed invention. We agree. We recognize the Examiner's assertion that McLaughlin's "rounded or hemispherical head is fully capable of articulation" (Ans. 7). McLaughlin makes clear that "proximal component 12 is firmly affixed to the proximal bony landmark (e[.]g. pelvis) 14 by means of methylmethacrylate bone cement, screws 20, bony ingrowth,

etc. in such a way that no motion occurs at the proximal component-bone interface 17” (FF). The Examiner failed to identify a disclosure in McLaughlin that suggests that McLaughlin’s prosthesis articulates about the rounded or hemispherical head of element 12. Accordingly, we are not persuaded by the Examiner’s unsupported conjecture.

The Examiner failed to articulate how McLaughlin would be modified with any one of Townley, Lane, Abouaf, Wright, or ASTM in order to make up for the foregoing deficiency in McLaughlin. At best, the Examiner identifies a teaching in Abouaf wherein ceramic is utilized “for articulating heads of joints” (Ans. 5). According to the Examiner, “[i]t would have been obvious to one of ordinary skill in the art to utilize a ceramic head . . . with the thumb implant of McLaughlin such that the prosthesis has reduced wear at the joint or articulating area” (*id.*). As discussed above, McLaughlin’s head does not articulate. Therefore, it is unclear how the Examiner proposes to apply Abouaf to reduce wear about a region that does not exist in McLaughlin’s device.

CONCLUSION OF LAW

The preponderance of evidence on this record fails to support a conclusion of obviousness. Accordingly, we reverse the rejection of:

1. Claims 21, 22, 25, 26, 28, 29, 40, and 41 under 35 U.S.C. § 103(a) as unpatentable over McLaughlin.
2. Claim 23 under 35 U.S.C. § 103(a) as unpatentable over the combination of McLaughlin and Townley.
3. Claim 24 under 35 U.S.C. § 103(a) as unpatentable over the combination of McLaughlin and Lane.

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4. Claims 31, 32, and 34-36 under 35 U.S.C. § 103(a) as unpatentable over the combination of McLaughlin and Abouaf.
5. Claim 37 under 35 U.S.C. § 103(a) as unpatentable over the combination of McLaughlin and Wright.
6. Claim 42 under 35 U.S.C. § 103(a) as unpatentable over the combination of McLaughlin and ASTM.

REVERSED

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